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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,132	11/26/2003	Gerald Duhamel	P1068US00	4651
77130 7590 02/18/2010 LABTRONIX CONCEPT C/O BENOIT & COTE, s.e.n.c. 1001, DE MAISONNEUVE BOULEVARD WEST SUITE 210 MONTREAL, QC H3A 3C8 CANADA				
EXAMINER				
RUSTEMEYER, MALINA K				
ART UNIT		PAPER NUMBER		
3714				
NOTIFICATION DATE		DELIVERY MODE		
02/18/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/722,132

Applicant(s)

DUHAMEL ET AL.

Examiner

Malina K. Rustemeyer

Art Unit

3714

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-21, 23-34 and 36-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-21, 23-34 and 36-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to applicant's response filed on 10/28/09.

Applicant responds to rejections. Claims 2-21, 23-34, and 36-45 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 2-8, 12, 13, and 40-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scarne's New Complete Guide to Gambling.

Concerning claim 41, Scarne teaches a method of providing a participation game among a plurality of players [pg. 158, lines 28-30], the method comprising the steps of: receiving from at least one of said players a play request to participate in said

participation game [pg. 158, lines 35-38]; associating said game card to said play request [pg. 158, lines 35-38]. The play request is the wager, and the game card is the ticket purchased. Scarne teaches associating a current draw result comprising at least two numbers to said play request [pg. 158, lines 38-40]. The current draw result is the last five digits of the U.S. Treasury balance. Scarne teaches establishing a play outcome for said play request, based on comparison of said current draw result and said game card [pg. 158, lines 35-42]; and determining whether a game ending state is achieved based on said comparison, and where if said game ending state is achieved, ending said participation game for player by preventing association of said current draw result with a further play request [pg. 158, lines 40-42]. The ending game state is achieved when the player's numbers match the last five digits of the U.S. Treasury balance. Scarne teaches if said game ending state is not achieved, maintaining said current draw result in its current form thereby having said current draw result remaining composed of a constant amount of said numbers (player's five-digit number stays the same) [pg. 158, lines 30-40], and associating said current draw result with a further play request (everyday there are a new last five digits of the U.S. treasury balance) [pg. 158, lines 38-42], wherein all of said play outcomes are based on said current draw result [pg. 158, lines 38-42], and wherein said play request resulting in said game ending state being achieved, establishes a winning player of said participation game [pg. 158, line 40- pg. 159, line 8]. Scarne discloses the claimed invention except for ending said participation game for all of said plurality of players by preventing association of said current draw result with a further play request. It would have been

obvious to one having ordinary skill in the art at the time the invention was made to create an electronic version of the game using a plurality of players that ends when a winner is selected, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routing skill in the art. *In re Venner*, 120 USPQ 192.

Concerning claim 44 (see further explanations in claim 41), Scame teaches a system for handling game related information in relation with a participation game played among a plurality of players [pg. 158, lines 28-30] and determination of a winning player among said plurality of players [pg. 158, lines 40-42], the system comprising: draw generation for generating a current draw result [pg. 158, lines 35-38], said current draw unchanging over said participation game thereby remaining composed of a constant amount of numbers until determination of said winning player [pg. 158, lines 32-35]; card distributing for providing said game card [pg. 158, lines 35-38]; request handling means for handling a play request from at least one of said plurality of players, comprising associating said game card and said current draw result to said play request and transmitting said game card and said draw result to said player [pg. 158, lines 35-40]; and end-of-game evaluation for evaluating fulfillment of an end-of-game criterion of said play request based on comparison of said game card to said current draw result before evaluating another play request, and, upon fulfillment of said end-of-game criterion [pg. 158, lines 35-40], ending said game in addition of determining said player to be the winning player of said participation game, whereby the system processes play requests independently from each other [pg. 158, lines 35-40].

Scame teaches drawing cards for the player and maintaining said current draw result in its current form **[pg. 158, lines 32-39]**. Scame discloses the claimed invention except for ending said participation game for all of said plurality of players by preventing association of said current draw result with a further play request and the game containing a draw register for storing said current draw result throughout the play of the participation game until the winning player is determined. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create an electronic version of the game using a plurality of players that ends when a winner is selected that would inherently incorporated some type of draw register for storing the numbers drawn by the player, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routing skill in the art. *In re Venner*, 120 USPQ 192.

Concerning claim 45 (see further explanations in claim 41), Scame teaches a method of providing a participation game among a plurality of players **[pg. 158, lines 29-30]**, the method comprising the steps of: beginning a new game for at least one player **[pg. 158, lines 32-38]**; drawing at least two numbers to form a current draw **[pg. 158, lines 32-38]**. Scame teaches drawing cards for the player and upon receiving a play request from a player: beginning a game play for said player; associating said play request to said current draw **[pg. 158, lines 32-38]**; generating a game number and associating said game card with said play request **[pg. 158, lines 32-40]**; establishing a game outcome for said play request based on comparison of said associated game number and said current draw **[pg. 158, lines 32-40]**. Scame lacks teaching drawing

game balls for the plurality of designations, and teaches drawing game numbers, however, it would be obvious to substitute game balls for playing cards because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Scarne teaches evaluating said game outcome according to a logical payout scheme and awarding an award corresponding to said evaluation **[pg. 158, line 40- pg. 159, line 8]**. Scarne does not specifically disclose a pay table, however, it would be obvious to arrange the logical payout scheme in a pay table format. Scarne teaches determining whether a game ending state is achieved based on said comparison **[pg. 158, lines 32-40]**, and where: if said game ending state is not achieved, continuing said game by allowing at least one further play request to be associated with said current draw **[pg. 158, lines 32-40]**; and regardless of whether or not said game ending state is achieved, ending said game play for said player **[pg. 158, lines 40-42]**. Scarne discloses the claimed invention except for ending said participation game for all of said plurality of players by preventing association of said current draw result with a further play request. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create an electronic version of the game using a plurality of players that ends when a winner is selected, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routing skill in the art. *In re Venner*, 120 USPQ 192.

Concerning claim 2, Scarne teaches said end-of-game criterion comprises a unique criterion associated with a unique end-of-game prize **[pg. 158, line 40- pg. 159, line 8]**.

Concerning claim 3, Scarne teaches identifying a winning game card upon a positive evaluation of said end-of-game criterion **[pg. 158, line 40- pg. 159, line 8]**.

Concerning claim 4, Scarne teaches signaling the end of said game upon the game ending state being achieved **[pg. 158, line 40- pg. 159, line 8]**. The current player's game is over for the ticket that has won.

Concerning claims 5, and 6, Scarne teaches initiating the use of a new current draw result or game upon the game ending state being achieved and reception of a first play/game request for participation into said participation game **[pg. 158, line 35- pg. 159, line 8]**. After the game is over, the player then starts over and purchases a ticket.

Concerning claim 7, Scarne teaches generating said game card in response to said play request **[pg. 158, lines 32-38]**.

Concerning claim 8, Scarne teaches randomly selecting said game card among a set comprising a plurality of game cards upon reception of said request for a play **[pg. 158, lines 32-3]**.

Concerning claims 12 and 13, Scarne teaches comparing said game card with current draw result against prize criteria; and awarding prizes to said winning player based on said comparison, further comprising associating at least one of said prize criteria with said end-of-game criterion **[pg. 158, line 40- pg. 159, line 8]**.

Concerning claim 40, Scarne teaches said participation game starts upon reception of a first play request in relation with said participation game [pg. 158, lines 32-38]. The player purchases a ticket as a first game request.

Concerning claim 42, Scarne teaches wherein the step of receiving from at least one of said players a play request is performed after the step of maintaining said current draw result in its current form when said game ending state is not achieved [pg. 158, lines 32-38]. The player can purchase as many tickets as he/she wants; therefore, the player is making a play request after maintaining the previous lottery ticket numbers.

Concerning claim 43, Scarne teaches wherein the method is performed at least twice, each time the method being performed being over reception of at least one said play request [pg. 158, lines 32-38]. The players can continue to play as many games as they want

5. Claims 9-11, 14-20, 23-27, 29-34, and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scarne's New Complete Guide to Gambling in view of Itkis et al. (US Patent Publication 2002/0094860, hereinafter "Itkis"). Scarne teaches the invention substantially as claimed, but fails to teach details of card storage means, validation methods, and communication with central server. The publication to Itkis discloses a fully automated bingo session.

Regarding claim 9, Itkis teaches generating said game card set and storing said game card sets in a card storage means [0061].

Regarding claim 10, Itkis teaches wherein said step of associating a game card further comprises retrieving said game card from said game card storage means **[0061]**.

Regarding claim 11, Itkis teaches wherein the generating a game card set further comprises flagging game cards of the game card set that fulfills said end-of-game criterion upon comparison of said game card to said current draw result, wherein the step of flagging game cards is performed before the step of storing said game card set **[0061]**.

Regarding at least claims 14, Itkis discloses unique end of game criterion associated with a unique prize, such as one prize amount for a simple BINGO and another prize amount for a specific pattern; identifying a winning game card, **[0014]**, issuing a prize and associating prize with end of game criterion, **[0014]**; positive end of game criterion signals the end of the game, worded a different way, the game state changes to "end of game", **[0014]**, positive end of game criterion starts a new game, **[0014]**, generating said game card in response to a request to play a game, **[0048]**.

Regarding at least claims 15 and 16, Itkis discloses wherein all steps of said method are performed in a central game distribution system, wherein at least on of the steps of said method is performed on a discrete gaming apparatus remotely in communication with a central game distribution system wherein at least one other step of the method is performed **[0012]**.

Regarding at least claims 17-20, Itkis discloses that players must validate their tickets to get a prize, this validation would determine that they are a winner; this validation completes that session for them; the validation process does not prevent new

requests from taking place, the step of determining whether a game ending state is achieved further comprises registering said completion of said validation process **[0015/0016]**.

Regarding at least claims 23-27 and 29-32, Itkis discloses a draw communication means for handling communication of current draw result and card drawing means, **[Fig. 1 items 2, 9, 33, 44, 129]**; card communication means, **[Fig. 9]**; archiving means for archiving distributed play information, **[Fig. 9 items 4, 38, 40]**; card storage and distribution means for storing a card set comprising a plurality of cards ready to be associated with play requests, **[Fig. 9 items 4, 38, 33]**; card generation means, **[0042]**; the system comprises a plurality of separate physical entities, and draw generating means and said request handling means each form a distinct one of said separate physical entities, **[Fig. 1 item 2]**; draw generation means is a bingo blower, **[Fig. 1 Item 9]**; prize evaluation means, remotely connected to request handling means, **[Fig. 1 Item 2]**.

Regarding claim 33, Itkis does not explicitly disclose monitoring jackpot prizes, however Itkis does disclose monitoring prizes in general on both a TV monitor as well as a portable monitor. It is well known in the art that a Jackpot prize or progressive prize is common to all forms of gaming, including keno, bingo, slots, and lotteries (such as power ball).

Concerning claim 34, Itkis teaches a plurality of draw registers with each one of them being associated with a different game title **[0042]**.

Regarding at least claims 36 and 37, Itkis discloses a criteria evaluations means, that can use criteria to validate a win, **[Fig. 1 Item 12 and 7]**, in communication with an end of game evaluation means, **[Fig. 1, Item 2]**.

Regarding claim 38, Itkis discloses the system further comprising idle means for idling the handling means until completion of the validation process **[0014/0049/0050]**.

Regarding claim 39, Itkis discloses constantly monitoring all active cards in a set for potential winning, if no card fulfills the end of game criteria, that state of the game is noted and subsequent draws occur until a card meets the end of game criteria based on said comparison of said game card to said current draw result **[0057]**.

It would have been obvious to combine the teachings of Scarne with the teachings of Itkis because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scarne's New Complete Guide to Gambling in view of Itkis et al. (US Patent Publication 2002/0094860, hereinafter "Itkis") and the Kentucky State Gaming Regulations. Scarne teaches the invention substantially as claimed, but fails to teach details of card storage means, validation methods, and communication with central server. The publication to Itkis discloses a fully automated bingo session.

Regarding claim 21, Scarne does not explicitly disclose limiting the time for game validation. The Kentucky State Gaming Regulations not only disclose, but also mandate that lottery tickets will have limited time for validation. 154A.110 (2) (e). It would be obvious to one of ordinary skill in the art at the time of the inventions to combine the matching number game of Scarne with the Kentucky State Gaming Regulations, as law would require it. Furthermore, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

7. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scarne's New Complete Guide to Gambling in view of the Kentucky State Gaming Regulations.

Concerning claim 28, Scarne does not explicitly disclose preventing duplicate cards. The Kentucky State Gaming Regulations has a specific rule for when two players are both owed a prize, that they must split the winnings. 154A.110 (2) (d). Itkis discloses in 0017 that it is important and a goal of the invention to attract players to the casino. It would be obvious to one of ordinary skill in the art at the time of the invention to prevent the duplication of cards in the Itkis system in order to insure that "high-rollers" and other players will not have to share prizes with anyone and therefore better attract them to a certain casino. Furthermore, it would have been obvious to combine the teachings of Scarne with the teachings of Kentucky State Gaming Regulations

because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Examiner's Note

The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Response to Arguments

8. Applicant's arguments filed 10/28/09 have been fully considered but they are not persuasive. Applicant argues Scarne does not teach "associating a current draw result comprising at least two numbers to said play request." However, Examiner disagrees. The term current is interpreted to mean each day for the week. The current draw results are the results for the current week. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., at the time of the ticket sale) are not recited in

the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues Scame does not teach "determining whether a game ending state is achieved based on said comparison." However, Examiner disagrees. The claim language does not precisely state when the comparison happens. Furthermore, when the player wants to cash in the winning ticket, the ticket has to be submitted to the ticket collector (see pg 160, lines 7-9), therefore making it a game ending state. Submitting your winning ticket to the ticket collector is one example of a game ending state.

Applicant argues Scame does not teach "if said game ending state is achieved, ending said participation game for all of said plurality of players by preventing association of said current draw result with a further play request". However, as stated in above action, Scame discloses the claimed invention except for ending said participation game for all of said plurality of players by preventing association of said current draw result with a further play request. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create an electronic version of the game using a plurality of players that ends when a winner is selected, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routing skill in the art. *In re Venner*, 120 USPQ 192.

Applicant argues Scarne does not teach "wherein all of said play outcomes are based on said current draw result." However, Examiner disagrees. All of the winning and losing outcomes are based on current draw result because in order to determine if they are winning or losing outcomes, the player must see the current draw result.

Concerning Applicant arguments towards a game ending state, Examiner disagrees. When the player wants to cash in the winning ticket, the ticket has to be submitted to the ticket collector (see pg 160, lines 7-9), therefore making it a game ending state. Submitting your winning ticket to the ticket collector is one example of a game ending state. Therefore, Scarne reads on the claim language.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Malina K. Rustemeyer whose telephone number is (571)270-1297. The examiner can normally be reached on Mon. - Thurs., 7 AM - 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art Unit 3714

Malina K. Rustemeyer
Examiner
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/M. K. R./
Examiner, Art Unit 3714

